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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,333	02/12/2002	Claude C. Granel	IR 3534	5706

7590 09/23/2003
KILYK & BOWERSOX, P.L.L.C.
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EXAMINER

ROBERTSON, JEFFREY

ART UNIT	PAPER NUMBER
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1712

10

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 10

Office Action Summary

Application No.

10/074,333

Applicant(s)

GRANEL ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-12, 14, 15 and 18-26 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: on page 38 of the specification, the use of the trademark FASCAT® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. In this case, the trademark does not appear in all capital letters.

Also in line 4 of paragraph [0027] on page 13, the group "2,5-dimethyhexyl" is not understood.

Appropriate correction is required.

Information Disclosure Statement

2. Regarding the information disclosure statement of July 9, 2003 (paper no. 9), it is noted that the certification used by applicant does not conform to the current certification required by 37 C.F.R. §1.97 (e)(1):

A statement under this section must state either:(1) That each item of information contained in the information disclosure statement was *first* cited in *any* communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement ... (emphasis added).

For the purposes of this application, the statement will be accepted. However, in the future, applicant should conform to the language set forth in the Code.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 6, 7, 10, 11, 14, 15, 18-21, and 23-26 are rejected under 35 U.S.C. 102(a) as being anticipated by Amin-Sanayei et al. (WO 01/34670 A1).

For claim 1, this rejection covers the situation where components a) and b) are the same. In Example 1, page 14, lines 10-26, Amin-Sanayei teaches the formation of a dispersion containing a latex with a pH of 4.6. This latex is a fluoropolymer containing sterically hindered silane groups. For claims 18 and 19, in column 4, line 6, Amin-Sanayei discloses that the composition is used as a coating. For claim 10, on page 4, lines 23-24, Amin-Sanayei teaches that only the fluorine containing alkylene monomer is required, meaning that a homopolymer would be formed. For claim 20, in column 3, lines 22-23, Amin-Sanayei teaches the fluoropolymer is crosslinked. For claim 21, on page 15, lines 15-18, the use of buffers such as phosphoric acid is taught.

For claims 2, 3, and 15, on page 4, lines 13-30, Amin-Sanayei teaches fluoropolymers containing one or more organo-silane functionalities that are sterically hindered groups corresponding to applicant's component b). The silane group would be present in the backbone as evidenced by the copolymerization of the silane with the

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fluorine containing monomers. For component a), on page 13, lines 26-28, Amin-Sanayei teaches that the fluoropolymers produced can be components in polymer blends specifically mentioning acrylates and poly(vinyl alcohols). For claims 6 and 11, on page 4, lines 23-30, Amin-Sanayei teaches that the fluoropolymer may be a copolymer, where there is a non-fluorine containing monomer. For claim 7, on page 5, line 7, Amin-Sanayei discloses that the fluoropolymer may be derived from vinylidene fluoride. For claim 14, and 23-26, on page 6, line 21, through page 7, line 26, Amin-Sanayei describes the preferred silane monomers corresponding to applicant's formulas I and II, where the R^1 group is a branched C3-C6 radical, R^2 represents an unsaturated group such as vinyl, and R^3 =alkyl. For claim 12, on page 6, line 9, Amin-Sanayei teaches a functional monomer such as vinyl acetate.

5. Claims 1, 18-21, 23, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al. (U.S. Patent No. 5,859,123).

This rejection covers situations where components a) and b) are the same. For claims 1, 18, and 19, in column 1, lines 56-67, Kobayashi teaches a water-based fluorine containing emulsion that is a one-package paint providing a coated film. In column 2, lines 29-44, Kobayashi teaches that this emulsion is produced by the copolymerization of a fluoroolefin and a olefinic-containing silicon compound. In column 2, lines 53-60, Kobayashi teaches that the fluoroolefin is a vinyl fluoride. In column 3, lines 5-52, Kobayashi teaches that vinylalkoxysilanes are preferred, and specifically names vinyltriisopropoxysilane. For claims 23 and 24, this silane falls within the definition of formula I, where $n=0$. It is noted that the aforementioned silane is part of a

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list named by Kobayashi. A genus does not always anticipate a claim to a species within the genus. However, when the species is clearly named, the species is anticipated no matter how many other species are additionally named. Ex parte A, 17 USPQ 2d 1716 (Bd. Pat. App. & Inter. 1990) See also In re Sivaramakrishnan, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982). For claim 20, in column 2, lines 8-14, Kobayashi teaches that the polymer is crosslinked. For claim 21, in column 4, lines 45-56, Kobayashi teaches that a carboxylic acid monomer is added to form the polymer. This monomer acts as the internal buffer as claimed in claim 21.

6. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Tomonori et al. (Machine Translation of JP 05-186907).

Note that for claim 15, component a), does not require the presence of a sterically hindered silane or silane containing group due to the presence of the word "optionally" in the claim. This rejection is given because the silane group is not required in the claim.

For claim 15, in paragraph [0004] of the translation Tomonori teaches a polymer blend of fluoropolymer and a vinyl system polymer. In paragraph [0011], Tomonori teaches that the fluoropolymer may be co-polymerized with a silyl monomer.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 4, 5, 9, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amin-Sanayei et al. (WO 01/34670 A1) and Chen et al. (U.S. Patent No. 5,621,038).

For claims 2, 4, 5, and 22, on page 4, lines 13-30, Amin-Sanayei teaches fluoropolymers containing one or more organo-silane functionalities that are sterically hindered groups corresponding to applicant's component b). On page 14, example 1, the polymer is formulated as a latex.

In column 2, lines 18-20, Chen teaches silane containing polymers that have a shelf life of 12 or 24 months, which is greater than the three months claimed by applicant in claim 22. In column 2, lines 59-68, Chen teaches polymers that contain sterically hindered silane groups. Here, for claims 2, 4, 5, 9, and 22, Chen teaches that the polymers are vinyl acrylics and that two different monomers may be used, resulting in a copolymer.

It is noted that Claim 5 is a product-by process claim. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Amin-Sanayei and Chen are analogous art in that they are from the same field of endeavor, namely stable dispersions of polymers containing sterically hindered silane groups that are used for storage stable coating compositions. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the combinations of Amin-Sanayei and Chen to arrive at applicant's compositions. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. . . . [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980)

Response to Arguments

9. Applicant's arguments with respect to claims 1-7, 9-12, and 14 have been considered but are moot in view of the new ground(s) of rejection. With respect to claim 15, in response to applicant's argument that the Tominori reference does not teach the presence of a sterically hindered silane, as pointed out in the rejection above, claim 15 does not require the presence of a sterically hindered silane. The word "optionally" in the claim indicates that the sterically hindered silane is not necessarily present.

Allowable Subject Matter

10. Claims 16 and 17 are allowed.

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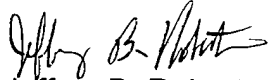
11. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR